

Claims 6 and 23-27 are rejected under 35 USC 103(a) as being unpatentable over MYERS in view of BOURDEAU (U.S. Patent No. 5,456,477).

Claim 17 is rejected under 35 USC 103(a) as being unpatentable over MYERS in view of MacDONNELL and MEIBOCK et al. (U.S. Patent No. 5,848,796, hereinafter "MEIBOCK").

Reply to Office Action and Summary of Interview

A. Summary of Interview

Applicant's undersigned representative wishes to extend his gratitude to Examiners Phan and Lerner for their consideration of his positions discussed during an interview on October 2, 2002.

During the interview, the propriety of the rejection based upon a combination of MYERS and MacDONNELL was discussed. Applicant's representative explained, e.g., that in view of the particular manufacturing techniques used by MYERS and MacDONNELL, it would not have been obvious that one skilled in the art would have found a modification of the frame of MYERS obvious in view of the teachings of MacDONNELL, as set forth in the Examiner's rejections. This issue has been discussed previously, and is presented again below in connection with Applicant's continued traverse of the rejections.

Also, the §112 rejection of claim 6 was addressed, with Applicant's representative agreeing to presenting an amendment that will overcome the rejection. This amendment has been presented herein and is specifically addressed below. Examiner Phan mentioned that it had been his understanding that the term "boss", as used in claim 6, related to element 7, e.g., as shown in Fig. 3, surrounding the holes 6. Instead, Applicant's representative explained, that the term "boss" in claim 6 is intended to encompass a short "rib", as shown, e.g., in Fig. 4, element 19, and as explained on page 11, lines 12-15.

During the interview, the Examiners agreed that the subject matter of each of claims 2 and 15 is allowable (i.e., that the rejections thereof would be withdrawn) and that the independent claims would be allowed if the subject matter of these claims were to be incorporated therein.

In the instant amendment, Applicant has chosen to rewrite claims 2 and 15 in independent form, but has not incorporated the subject matter into the independent claims, as such. However, Applicant's representative thanks the Examiners for their reconsideration of the rejection of claims 2 and 15.

In addition, Applicant has rewritten claim 16 in independent form, and submits that claim 16 is similar in subject matter to claim 15 and, at least for that reason, as further explained below, claim 16 should be found to be allowable.

B. Allowable Claims

As mentioned above, upon reconsideration by the Examiner at the interview, claims 2 and 15 were found to be allowable. Claim 2 refers to the stiffening ribs of the lateral and medial flanges as being "continuous" between opposite ends. Claim 15 refers to the stiffening ribs as having a curved shape having a downwardly facing concavity.

Claim 16 refers to the stiffening ribs as having a longitudinal portion that is intermediate the opposite ends, and that this intermediate portion has a "higher elevation relative to said opposite ends." This claim, therefore, like allowable claim 15, refers to the ribs as having a shape that extends upwardly from an end. Because the MYERS frame is made by extrusion, the ribs 32 ("convex, bulged or outward bowed portions" --- see column 6, line 20) extend straight longitudinally. Further, although Applicant respectfully disagrees with the combination of MYERS and MacDONNELL, even MacDONNELL does not address the feature of claim 16.

In view of the allowability of claim 2, Applicant has cancelled dependent claim 19, which had been directed to similar subject matter.

C. Withdrawal of Rejection of Claim 6 Under 35 USC 112

In the amendment to claim 6 being made herein, the expression "said boss having an outline devoid of a straight line" has been deleted. In addition, the expression "non-circular boss" has been added to the specification (on page 11, lines 12-15).

The subject matter of claim 6, as now amended, has support in the originally filed application, as well as in the first-filed application of which Applicant claims priority. No prohibited new matter has been added in the amendment.

In view of the amendment, reconsideration and withdrawal of the rejection is requested.

D. Withdrawal of Double Patenting Rejection

Being filed concurrently herewith is a terminal disclaimer, whereby the terminal part of any patent granted on the instant application that would extend beyond the expiration date of the full statutory term of U.S. Patent No. 6,293,563 is disclaimed and, further, whereby it is agreed that any patent granted on the instant application will be enforceable only for and during such period that the legal title to US '563 and the legal title to any patent granted on the instant application are the same.

In view of the filing of the terminal disclaimer, withdrawal of the rejection is requested.

In filing the terminal disclaimer, Applicant submits that he is doing so for the purpose of advancing prosecution of the instant application toward allowance and does not intend to have such filing considered as an acquiescence in the propriety of the double patenting rejection.

E. Withdrawal of Rejection Based Upon MYERS and MacDONNELL

Applicant respectfully submits that the rejection of claims 1-5, 7-16, 18-22, and 28-30 under 35 USC 103(a) as being unpatentable over MYERS in view of MacDONNELL should be withdrawn.

Applicant's position is based upon what he submits is current U.S. Patent and Trademark Office policy and the precedents of the Court of Appeals for the Federal Circuit.

In addition, Applicant submits that his arguments opposing the rejection have not been addressed.

Specifically, the frame of MacDONNELL, intended to be used with ice skates, is made punches and dies. See, e.g., the left column, lines 31-34. A longitudinally extending tubular section 10 is made in the frame side sections 4, 5, which are welded together, but provide a groove in the lower edge to receive a runner 6. See the left column, lines 48-55. An objective of MacDONNELL is to produce a strong frame (made of steel or a light weight alloy, as mentioned in the left column, lines 38-44), but one that is light in weight.

By contrast, it is the intention of MYERS to have the body of his chassis to have a substantially constant transverse cross section along its length (see column 3, lines 1-3 and column 4, lines 16-17), thereby enabling the chassis to be manufactured by an extrusion process.

Therefore, because the MYERS chassis is extruded, a longitudinally curved rib would not be possible.

As explained in *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984), a proposed modification is inappropriate as a consideration regarding obviousness under 35 USC 103 when such modification renders the prior art reference inoperable for its intended purpose. Although not specifically admitted in the rejection, it would be necessary to modify the manner by which the chassis of the MYERS skate is made if the teaching of MacDONNELL, relied upon in the rejection, were to be incorporated. However, such a change would be contrary to the disclosure of MYERS. In addition to *In re Gordon*, the Examiner's attention is respectfully directed to MPEP 2143.01, pages 2100-124 and 2100-125 (8th Edition, August 2001).

As explained on page 2100-125 of the MPEP, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)."

At least in view of the foregoing, Applicant requests that the rejection based upon the combination of MYERS and MacDONNELL be withdrawn.

F. Withdrawal of Rejection Based Upon MYERS and BOURDEAU

Applicant respectfully submits that the rejection of claims 6 and 23-27 under 35 USC 103(a) as being unpatentable over MYERS in view of BOURDEAU should be withdrawn.

Before discussing the merits of the rejected claims, Applicant notes that claim 6 has been amended (overcoming the §112 rejection) to specify that each of the flanges has a non-circular boss that extends "longitudinally other than in a straight line." Claim 16 refers to a type of rib that has a relatively short length, yet one that does not extend longitudinally along a straight line.

Neither MYERS nor BOURDEAU teach or suggest such an orientation. If, upon reconsideration, the Examiner were to consider relying upon the above-mentioned combination of MYERS and MacDONNELL in an obviousness rejection, Applicant would submit that claim 6 would be allowable at least for reasons given above.

Even without the amendment to claim 6, Applicant submits that MYERS and BOURDEAU would not be responsive to the limitations found in dependent claims 24 and 26,

in which the holes for the axles of the wheels are specifically recited and, further, in which the recited "bosses" do not surround the axle holes. Claims 25 and 27 (depending from claims 24 and 26) specifically call for the chassis to include the wheels.

At least in view of the amendment, reconsideration and withdrawal of the rejection of claims 6 and 23-27 is requested.

G. Withdrawal of Rejection Based Upon MYERS, MacDONNELL, and MEIBOCK

Applicant respectfully submits that the rejection of claim 17 under 35 USC 103(a) as being unpatentable over MYERS in view of MacDONNELL and MEIBOCK should be withdrawn.

Claim 17 describes the shapes of the lateral and medial flanges themselves, not taught or suggested by either MYERS or MacDONNELL. Specifically, claim 17 specifies that the flanges have top and bottom edges of end portions that extend both forwardly and downwardly. As examples, see Applicant's Figs. 1, 4, and 11 in particular.

First, Applicant submits that the rejection of claim 17 should be withdrawn at least for the reasons given above regarding the combination of MYERS and MacDONNELL.

In the rejection of claim 17, the Examiner additionally relies upon MEIBOCK as allegedly teaching the subject matter of the rejected claim and for allegedly suggesting that a modification of MYERS and MacDONNELL would have been obvious.

The reason given in support of the rejection is "to provide both vertical support for both front and rear portions."

Applicant respectfully submits that the reason is merely rhetorical. Both MYERS and MacDONNELL already provide vertical support for their front and rear portions. Applicant submits that the reliance upon MEIBOCK is only based upon an improper reconstruction of Applicant's invention, suggested only by Applicant. As mentioned previously, MYERS' frame has a straight longitudinal extent, inasmuch as it is produced by extrusion. Further, even if MacDONNELL were to be used for modifying MYERS, MacDONNELL has a frame shape that extends upwardly at the front. It would appear contrary to MacDONNELL, therefore, to somehow reverse the direction in which his frame extends.

At least for the reasons give above, reconsideration and withdrawal of the rejection of claim 17 is requested.

SUMMARY AND CONCLUSION

By means of the amendment above, Applicant submits that the application has been placed in condition for allowance. Accordingly, reconsideration and allowance are respectfully requested.

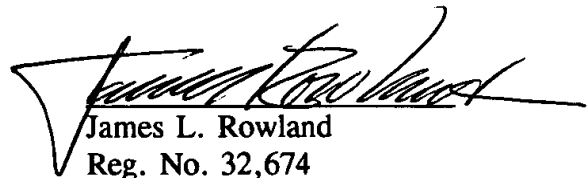
Any amendments to the claims presented above, which have not been specifically noted to overcome a rejection based upon prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach to such amendments.

A check is attached for payment of a claim fee. No additional fee is believed to be necessary. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Further, although no extension of time is believed to be necessary at this time, if it were to be found that an extension of time were necessary to render this reply timely and/or complete, Applicant requests an extension of time under 37 CFR 1.136(a) in the necessary monthly increment that would render this reply timely and/or complete and, in that event, the Commissioner would be authorized to charge any necessary extension of time fee under 37 CFR 1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone number given below.

Respectfully submitted,
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MARKED-UP VERSION OF AMENDMENTS**In the Specification**

The paragraph appearing on page 11, lines 12-15, is to be amended as follows:

(Amended) Conversely, each flange 12 is provided in its median zone with two superimposed pressed ribs 18, 19. Inasmuch as rib 19 has a relatively short length, i.e., relative to the rib 18, e.g., it might be better regarded as a boss, or an elongated or non-circular boss.

In the Claims

Claims 2, 6, 15, and 16 are to be amended as follows:

2. (Amended) A chassis [according to claim 1, wherein] for an in-line skate, said chassis comprising:

at least one substantially horizontal foot-bearing portion;

one longitudinally extending lateral flange extending downwardly from said foot-bearing portion, and one longitudinally extending medial flange extending downwardly from said foot-bearing portion;

each of said lateral flange and said medial flange having a top portion and a bottom portion, wherein:

both said top portions of said lateral flange and said medial flange being transversely spaced apart and both said bottom portions of said lateral flange and said medial flange being adapted to have attached therebetween at least one wheel;

each of said lateral flange and said medial flange having a stiffening rib, said stiffening rib having been made by pressing, extending longitudinally other than in a straight line;

each of said stiffening rib of said lateral flange and said stiffening rib of said medial flange comprises opposite ends, each of said stiffening ribs [rib] being continuous between said opposite ends.

6. (Twice Amended) A chassis for an in-line skate, said chassis comprising:
at least one substantially horizontal foot-bearing portion;
one longitudinally extending lateral flange extending downwardly from said foot-bearing portion, and one longitudinally extending medial flange extending downwardly from said foot-bearing portion;
each of said lateral flange and said medial flange having a top portion and a bottom portion, wherein:
both said top portions of said lateral flange and said medial flange being transversely spaced apart and both said bottom portions of said lateral flange and said medial flange being adapted to have attached therebetween at least one wheel;
each of said lateral flange and said medial flange [further] having a non-circular boss, said boss having been made by pressing, said boss extending longitudinally other than in [having an outline devoid of] a straight line.

15. (Amended) A chassis [according to claim 1, wherein] for an in-line skate, said chassis comprising:
at least one substantially horizontal foot-bearing portion;
one longitudinally extending lateral flange extending downwardly from said foot-bearing portion, and one longitudinally extending medial flange extending downwardly from said foot-bearing portion;
each of said lateral flange and said medial flange having a top portion and a bottom portion, wherein:
both said top portions of said lateral flange and said medial flange being transversely spaced apart and both said bottom portions of said lateral flange and said medial flange being adapted to have attached therebetween at least one wheel;
each of said lateral flange and said medial flange further having a stiffening rib, said stiffening rib having been made by pressing, extending longitudinally other than in a straight line;
said stiffening rib of said lateral flange and said stiffening rib of said medial flange have longitudinally extending curved shapes, said curved shapes having a downwardly facing concavity.

16. (Amended) A chassis [according to claim 1, wherein] for an in-line skate, said chassis comprising:

at least one substantially horizontal foot-bearing portion;

one longitudinally extending lateral flange extending downwardly from said foot-bearing portion, and one longitudinally extending medial flange extending downwardly from said foot-bearing portion;

each of said lateral flange and said medial flange having a top portion and a bottom portion, wherein:

both said top portions of said lateral flange and said medial flange being transversely spaced apart and both said bottom portions of said lateral flange and said medial flange being adapted to have attached therebetween at least one wheel;

each of said lateral flange and said medial flange further having a stiffening rib, said stiffening rib having been made by pressing, extending longitudinally other than in a straight line;

both said stiffening rib of said lateral flange and said stiffening rib of said medial flange have a longitudinal portion intermediate of opposite ends, said intermediate portion having a higher elevation relative to said opposite ends.